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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,524	06/14/2000	Carl Bader	ENSQ-0204	7704

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EXAMINER

FAULK, DEVONA E

ART UNIT PAPER NUMBER

2644

DATE MAILED: 08/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/594,524

Applicant(s)

BADER ET AL

Examiner

Devona E. Faulk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 20-39, 45, 52 and 54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45 and 52 is/are allowed.
- 6) ☒ Claim(s) 1 and 20-25 is/are rejected.
- 7) ☒ Claim(s) 2-12, 14 and 26-39 is/are objected to.
- 8) ☒ Claim(s) 13, 15-19, 40-44, 46-51 and 53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Regarding the double patent rejection of claims 20-25, the applicant has stated, on page 16, that he is prepared to submit a terminal disclaimer upon an indication of allowance. The examiner has determined that the application is patentable. A terminal disclaimer needs to be filed. The double patent rejection is maintained until a terminal disclaimer is filed.

2. Applicant's arguments filed 5/26/04 in Paper No. 13/B have been fully considered but they are persuasive. Regarding claim 1, the applicant asserts on page 17, lines 14-23 that the amendment to claim 1 overcomes the prior art. Additionally, the applicant asserts in lines 24-26 that "the MPEP section 2111.01 generally provides that the words of a claim must be read as they...?" **Line 26 of page 17 does not finish on page 18.** Nevertheless, MPEP section 2111.01 provides that words of a claim must be given their prior meaning. The applicant's asserts that the examiner's reading of Mizakami's line output audio amplifier (2) as a "primary connector" is in error citing MPEP section 2111.01. The examiner agrees. The applicant has provided a clear definition or explanation of "primary connector" (specification, page 11, lines 7-14). Although Mizakami's line output audio amplifier does not read on "primary connector", the jack (J) could read on "primary connector". However, prior fails to explicitly disclose or make obvious the features of the audio circuit with primary and secondary connectors as claimed. The examiner found a 112, lack of antecedent basis rejection in claim 1. A rejection will follow. Once this matter is corrected, claim 1 will be in condition for allowance.

3. Regarding claim 2-12,14 and 21-39, the applicant asserts, on page 18, lines 20-24 that these pending claims are allowable to the dependencies from an allowable claim. As stated

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above regarding claim 1, there is a 112 rejection matter that needs to be corrected, so those claims dependent upon claim 1 will be allowable due to their dependency on claim 1 once the 112 rejection matter has been corrected. As stated above regarding claim 20, once a terminal disclaimer has been filed, claim 20 and therefore its dependent claims will be allowable.

4. Regarding claims 45 and 52, the applicant asserts, on page 18, lines 9-19, that Mizukami fails to teach or suggest the audio circuit adaptable to include the secondary connector as recited in claim 45 or the step of removably coupling a secondary connector to the sound source via the header as recited in claim 52. The applicant agrees and has determined that prior art fails to explicitly state or make obvious the audio circuit or method of coupling as claimed. The secondary connector circuit includes a secondary socket being placed apart from the audio circuit having different connection features including the header switch to disconnect the sound source with the primary connector and allow the secondary connector to receive the audio signal.

Claims 45 and 52 are allowable.

5. Regarding newly recited claim 54, the applicant asserts on page 18, lines 15-19 that the prior art of record, Mizukami fails to disclose the recited claim language. The examiner agrees. However, claim 54 is objected to because the examiner has determined that there is an error on line 10. Once the error is corrected, claim 54 will be allowable. See section under claim objections.

6. Claims 13,15-19, 40-44,46-51 and 53 have been withdrawn from consideration but have not been cancelled. They need to be cancelled before an allowance can be issued.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. **Claims 20-25** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1,3,4,5 of U.S. Patent No.6,491,533.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 20-25 claim a dual configuration audio system with the same features as the dual configuration sound card system of claims 1,5. Claim 20-25 are overall broader than claims 1,5 and thus it would have been obvious that anything that infringed on the narrower claims 1,5 would infringe on the broader claims 20-25 .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

9. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said header first contact" in lines 8 and 11; "said header second contact" in lines 14 and 15; "said header ground contact" in lines 13,15-16; and "said

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secondary circuit " in lines 20 and 21. There is insufficient antecedent basis for this limitation in the claim. The limitation, " header first contact" , should read "first contact" as recited in line 5. The limitation, "header second contact" should just be "second contact" as recited in line 6. The limitation, "header ground contact" should be "ground contact" as recited in line 7. The limitation, "secondary circuit" should be "said secondary connector circuit", as recited in line 9.

Claim Objections

10. **Claim 54** objected to because of the following informalities: In line 10, the claim language recites " such as to mute the audio signal at the second audio output terminal". The examiner has determined that it should read "such as to mute the audio signal at a primary audio output terminal" or " at a first audio output terminal". Appropriate correction is required.
11. **Claims 2-12,14** would be allowable if claim 1 is rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
12. **Claims 26-39** would be allowable once the terminal disclaimer has been filed to overcome the double patent rejection of claims 20-25.

Allowable Subject Matter

13. **Claims 45 and 52** are allowable. See number 4 under "Response to Arguments".

Conclusion


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devona E. Faulk whose telephone number is 703-305-4359. The examiner can normally be reached on 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER